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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/639,929	08/12/2003	Martin Herke Oyevaar	08CL7254-3	7277

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CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER	
SHIPPEN, MICHAEL L	
ART UNIT	**PAPER NUMBER**
1621	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/639,929	OYEVAAR ET AL.	
	Examiner	Art Unit	
	MICHAEL L. SHIPPEN	1621	

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-27 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/20/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112[1]

Claim 12 is rejected under 35 USC 112, second paragraph, as failing to particularly point out the claims invention. The claim contains a typo which confuses the claim. It appears that "19" should read "1,".

Double Patenting

Claim 8 is rejected under 35 U.S.C. 101[2] as claiming the same invention as that of claim 12 of prior U.S. Patent No. 6,635,788. This is a double patenting rejection.

Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting[3] as being unpatentable over claims 1-26 of U.S. Patent No.

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[1] The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[2] A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

[3] The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

6,635,788 optionally in view of USP 5,786,522 and "Kirk-Othmer Encyclopedia of Chemical Technology," (4th Ed., Vol. 19, pp. 584-599 (1996)). The instant claims 1-14 differ from the claims of USP 6,635,788 only slightly by reciting that feed stream comprises 60 wt % of more of phenol. However, this clearly conflicts with the patent claims, which embrace this amount and makes specific reference to amounts such as 60-80 wt % in claim 12. The instant claims 15-18 differ from the claims of USP 6,635,788 only slightly by reciting that the recycle stream comprises about 6 to 22 wt % of the reactor effluent. However, this clearly conflicts with the patent claims, which embrace this amount and makes specific reference the same amount as shown by claim 6 of the patent. Claims 19-27 recite the process of the patent claims and the additional step of using the bisphenol product to prepare a polycarbonate. This is in fact a method of use contemplated by the patent, note lines 10-11 of column 1. One would not be able to practice the process of the patent and use the product produced therefrom in a normal way without infringing the instant claims. In effect, if a patent was granted to the instant claims, such would improperly extend the right to exclude others from the practical use of the patent process. Moreover, the additional steps are an obvious modification of the patent process since it is well known to prepare

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In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

polycarbonates from bisphenols that have be prepared in a manner similar to the patented process, note USP 5,786,522. It would be readily apparent to those of ordinary skill in the art that the polycarbonates could be prepared from bisphenols made by the patented process. Moreover, with respect to multi-step synthetic procedures involving a combination of individually well known chemical reactions, it has been held that one of ordinary skill in the relevant art is charged with knowledge of the individual chemical reactions and their combination to produce a desired end product would have been obvious, *In re Payne*, 203 USPQ 245; *In re Winslow*, 151 USPQ 48; *In re Kamlet*, 88 USPQ 106. The recited step of the polycarbonate preparation is a well-known standard method of preparation as shown by "Kirk-Othmer Encyclopedia of Chemical Technology".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
June 22, 2004

MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621